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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,215

03/24/2006

Dieter Doehring

BARDP0126US

4813

23908 7590 05/25/2010  
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EXAMINER

O'HERN, BRENT T

ART UNIT

PAPER NUMBER

1783

MAIL DATE

DELIVERY MODE

05/25/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,215	<b>Applicant(s)</b> DOEHRING, DIETER	
	<b>Examiner</b> BRENT T. O'HERN	<b>Art Unit</b> 1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4,8-14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4,8-11 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claims***

1. Claims 2, 4, 8-14 and 17-20 are pending with claims 12-14 withdrawn.

### **WITHDRAWN REJECTIONS**

2. All rejections of record in the Office action mailed 10/13/2009 have been withdrawn due to Applicant's amendments in the Paper filed 3/1/2010.

### **NEW REJECTIONS**

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

4. Claims 2, 4, 10-11 and 17-20 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring (WO 00/44984) published August 3, 2000 with evidence by Dohring (US 6,835,421) which is interpreted as being the English equivalent of ('984) and claims priority to ('984) in view of O'Dell et al. (US 5,545,476) and Shirono et al. (WO 01/21529) with Shirono et al. (US 6,994,834) interpreted as being the English equivalent of ('529).

Regarding claims 2, 4, 11 and 17-20, Dohring ('984) teaches paper for a laminate panel with a decorative paper provided with a décor and is impregnated with an amino resin for forming a resin matrix and comprises abrasion-resistant particles having a diameter of 50 to 200  $\mu\text{m}$ /(90 to 130  $\mu\text{m}$ ) made of silicon carbide or aluminum oxide and containing corundum that are coated with a silane adhesion promoter and are integrated into the resin matrix (*See col. 1, l. 47 to col. 2, l. 11 and Abstract.*), however,

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fails to expressly disclose the outer coating consisting essentially of an amino-silane adhesion promoter.

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “**consisting essentially of**” will be construed as equivalent to “comprising”. See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 (“PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”). MPEP 2111.03 Also, if an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

O’Dell (‘476) teaches a paper for a laminate with abrasion resistant particles coated with a silane adhesion promoter (*See col. 6, ll. 42-48.*) for a structure having three or more layers (*See col. 4, ll. 4-26 and 42-58 and Abstract.*) for the purpose of providing an aesthetic laminate with better initial better wear resistance (*See col. 6, ll. 42-48 and Abstract.*).

Shirano (‘529) teaches using an amino silane adhesion promoter for modifying silica powder (*See Abstract and col. 2, ll. 29-67.*) for the purpose of significantly increasing the adsorption amount of the anion source (*See col. 2, ll. 63-67.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to use an amino silane adhesion promoter as taught by Shirono ('529) and O'Dell ('476) in Dohring ('984) in order to provide a paper having particles with increased adsorption capacity for an aesthetic laminate having better initial wear resistance

Regarding claim 10, Dohring ('984) obviously teaches the abrasion resistant particles being in a plane (*See col. 1, l. 47 to col. 2, l. 11 and Abstract where the paper is planar, thus, providing for the particles being embedded within the paper to also be in a planar orientation.*).

5. Claims 2, 4, 8-11 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring et al. (US 2003/0138600) in view of O'Dell et al. (US 5,545,476) and Shirono et al. (WO 01/21529) with Shirono et al. (US 6,994,834) interpreted as being the English equivalent of ('529).

Regarding claims 2, 4, 8-9, 11 and 17-20, Dohring ('600) teaches paper for a laminate panel with a decorative paper filled with an acrylate provided with a décor having a weight of 20 to 60 g/m<sup>2</sup> and is impregnated with an amino resin for forming a resin matrix and comprises abrasion-resistant particles having a diameter of 50 to 200  $\mu\text{m}$ /(90 to 130  $\mu\text{m}$ ) made of silicon carbide or aluminum oxide and containing corundum that are coated with a silane adhesion promoter and are integrated into the resin matrix (*See paras. 20-31.*), however, fails to expressly disclose the outer coating consisting essentially of an amino-silane adhesion promoter.

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “**consisting essentially of**” will be construed as equivalent to “comprising”. See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 (“PPG could have defined the scope of the phrase consisting essentially of’ for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”). MPEP 2111.03 Also, if an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

O’Dell (‘476) teaches a paper for a laminate with abrasion resistant particles coated with a silane adhesion promoter (*See col. 6, ll. 42-48.*) for a structure having three or more layers (*See col. 4, ll. 4-26 and 42-58 and Abstract.*) for the purpose of providing an aesthetic laminate with better initial better wear resistance (*See col. 6, ll. 42-48 and Abstract.*).

Shirono (‘529) teaches using an amino silane adhesion promoter for modifying silica powder (*See Abstract and col. 2, ll. 29-67.*) for the purpose of significantly increasing the adsorption amount of the anion source (*See col. 2, ll. 63-67.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant’s invention was made to use an amino silane adhesion promoter

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as taught by Shirono ('529) and O'Dell ('476) in Dohring ('600) in order to provide a paper having particles with increased adsorption capacity for an aesthetic laminate having better initial wear resistance

Regarding claim 10, Dohring ('600) obviously teaches the abrasion resistant particles being in a plane (*See paras. 20-31 where the paper is planar, thus, providing for the particles being embedded within the paper to also be in a planar orientation.*).

**6.** Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring (WO 00/44984) published August 3, 2000 with evidence by Dohring (US 6,835,421) which is interpreted as being the English equivalent of ('984) and claims priority to ('984) in view of O'Dell et al. (US 5,545,476), Shirono et al. (WO 01/21529) with Shirono et al. (US 6,994,834) interpreted as being the English equivalent of ('529) and Jaisle et al. (US 4,473,613).

Dohring ('984), O'Dell ('476) and Shirono ('529) teach the paper discussed above, however, fail to expressly disclose the paper having a weight of 20 to 60 g/m<sup>2</sup> and being filled with an acrylate.

However, Jaisle ('613) teaches providing an acrylate filled paper having a décor having a weight of 20 to 60 g/m<sup>2</sup> (*See Abstract, col. 2, ll. 52-68. col. 3, ll. 31-37 and col. 4, ll. 35-40.*) for the purpose of providing a material that easy to form, resistant to discoloration, can be printed and is useful in high or low pressure laminates (*See col. 4, ll. 35-40.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to use an acrylate filled paper having the

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above weight as taught by Jaisle ('613) in Dohring ('984) in order to provide a product that is easy to form, resistant to discoloration, can be printed and is useful in various types of laminates.

### **ANSWERS TO APPLICANT'S ARGUMENTS**

7. In response to Applicant's arguments (*See p. 4, of Applicant's Paper filed 3/1/2010.*) regarding the canceled "free of amino resin" language per claim 19, it is noted that said arguments are moot since said language has been canceled.

8. In response to Applicant's arguments (*See p. 5, para. 3 of Applicant's Paper filed 3/1/2010.*) that none of the prior art teaches an adhesion promoter consisting essentially of an amino-silane, it is noted that the Examiner does not disagree that the prior art does not use this specific language, however, as discussed above, the examiner interprets the consisting essentially of language to be equivalent to "comprising" as there is not a clear indication in the specification or claims of what the basic and novel characteristics actually are.

9. In response to Applicant's arguments (*See p. 5, para. 4 of Applicant's Paper filed 3/1/2010.*) that Dohring ('984) does not teach particles coated with an adhesion promoter but rather combining the adhesion promoter with the particles and the adhesion promoter acts as a dispersion instead of an adhesion promoter, it is noted that Applicant's arguments are not persuasive as combining the adhesion promoter with the particles results in coated particles. Furthermore, Dohring ('984) specifically describes the silane material as an "adhesion promoter".



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**10.** In response to Applicant's arguments (*See p. 6, para. 1 of Applicant's Paper filed 3/1/2010.*) that even if Dohring's ('984) material is interpreted as coating the particles, there is also a melamine resin which is excluded by the consisting essentially of language, it is noted that Applicant's arguments are not persuasive as the consisting essentially of language is equivalent to "comprising" for the reasons discussed above.

**11.** In response to Applicant's arguments (*See p. 6, para. 2 of Applicant's Paper filed 3/1/2010.*) that the melamine resin as taught by O'Dell ('476) is excluded by the consisting essentially of language for the same reasons as discussed with respect to Dohring's ('984), it is noted that Applicant's arguments are not persuasive as the consisting essentially of language is equivalent to "comprising" for the reasons discussed above.

**12.** In response to Applicant's arguments (*See p. 6, para. 3 of Applicant's Paper filed 3/1/2010.*) that Dohring ('600), which is similar to Dohring ('984), does not teach particles coated with an adhesion promoter but rather combining the adhesion promoter with the particles and the adhesion promoter acts as a dispersion instead of an adhesion promoter, it is noted that Applicant's arguments are not persuasive as combining the adhesion promoter with the particles results in coated particles. Furthermore, Dohring ('600) specifically describes the silane material as an "adhesion promoter".

**13.** In response to Applicant's arguments (*See p. 7, paras. 2-3 of Applicant's Paper filed 3/1/2010.*) that Jaisle ('613) does not teach claims 8-9 because the melamine/formaldehyde resin is excluded by the consisting essentially of language, it is

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noted that Applicant's arguments are not persuasive as the consisting essentially of language is interpreted equivalent to "comprising" for the reasons discussed above.

**14.** Applicant does not set forth any precise arguments regarding cancelled claim 16.

**15.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT T. O'HERN whose telephone number is (571)272-6385. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brent T O'Hern/  
Examiner, Art Unit 1783  
May 5, 2010

/Elizabeth M. Cole/  
Primary Examiner, Art Unit 1782